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09/977,686	10/16/2001	Joseph R. Nardone	003636.0125	3773
<div>7590 01/09/2009</div> <div>William H. Bollman Manelli Denison &amp; Selter PLLC 2000 M Street, N.W. Suite 700 Washington, DC 20036</div>				
EXAMINER				
CHANKONG, DOHM				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/977,686

**Applicant(s)**

NARDONE ET AL.

**Examiner**

DOHM CHANKONG

**Art Unit**

2452

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 6, 7 and 9-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 6, 7, and 9-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. This action is in response to Applicant's request for continued examination filed on 11/10/2008. Claims 1, 15, 20, 21, 26, and 27 are amended. Claims 3 and 4 are canceled. Claims 5 and 8 had been previously canceled. Thus, claims 1, 2, 6, 7, and 9-31 are presented for further examination.
2. This action is a non-final rejection.

***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/10/2008 has been entered.

***Response to Arguments***

4. Applicant amends claims 1, 15, 20, 21, 26, and 27 to include limitations from canceled claims 3 and 4. Amended claims 1, 15, 20, 21, 26, and 27 now recite launching a first synchronization process on a personal data assistant in response to a synchronization instruction and launching a second synchronization process on a host device in response to the same synchronization instruction. Applicant argues that none of the cited prior art references disclose these features. However, Alam discloses both claimed limitations.

Alam discloses the commonly known synchronization event of when a PDA is first attached to desktop [column 12 «line 64» to column 13 «line 2»]. When connected, the synchronization managers for both the PDA and the desktop are initiated and begin communications to determine what objects need to be synched between the PDA and desktops [column 13 «lines 1-4»]. Upon determining that there is a need for synchronization, each respective synchronization manager calls (launches) appropriate method calls to perform synchronization on each device [column 10 «lines 1-23» | column 13 «lines 38-49»]. Alam's methods or interfaces read on Applicant's claimed synchronization processes because they are launched in response to a synchronization event (when the PDA is connected to the PC). The methods launched on the PC and the PDA also synchronize the data between the devices.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2, 6, 7 and 9-31 are rejected under 35 U.S.C. §103(a) as being unpatentable over Alam et al, U.S Patent No. 6.324.544 [“Alam”], in view of Hawkins et al, U.S Patent No. 5.884.323 [“Hawkins”], in further view of Grambihler et al, U.S. Patent No. 6.560.655 [“Grambihler”].

6. Claims 15 and 20 contain language that do not have any patentable weight. Claim scope is not limited by claim language that does not limit a claim to a particular structure. *MPEP §2111.04*. "Adapted to" clauses are one example of claim language that may raise a question as to the limiting effect of the language in a claim. *MPEP §2111.04*. Here, Applicant's system claims rely on the "adapted to" clause to specify that a personal data assistant and host device are adapted to perform a launching function. The use of the "adapted to" clause fails to limit the system claim to a specific structure. Thus, the phrases are do not have any patentable weight. Applicant should amend the claims so that the claimed features limit the PDA and the host device to a particular structure, for example, by claiming a specific hardware component that performs the function.

7. Alam disclosed a method for synchronizing file objects in object stores between a mobile device and a host computer. In an analogous art, Hawkins disclosed a method for synchronization process negotiation between a handheld computer systems and a host computer on which data are to by synchronized. In an analogous art, Grambihler disclosed a system including a synchronization manager for standardizing the synchronization of separate programs.

8. Concerning claims 1, 15, 20, 21, 26, and 27, Alam did not explicitly state that the synchronization instruction comprises a command that passes control to a particular application after synchronization. Although Alam refers to synchronizing objects upon connection of the devices, he is not specific on this aspect and so is not explicit about the commands within the synchronization instruction.

However, Hawkins discloses this feature as his system contains a command that passes control to particular a particular application after synchronization is complete [column 8 «lines 11-15»]. Specifically, Hawkin's SyncUnRegister() command ends the synchronization and passes control to the sync manager library. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Alam by adding the ability to specify when control of the processing should be passed to a different application when synchronization is complete as taught by Hawkins. Here the combination satisfies the need for efficiently ending the synchronization while specifying which application should continue running on the PDA.

While Alam and Hawkins disclose passing control to a different application after executing a synchronization instruction and that these synchronization instructions contain at least one parameter, they do not expressly disclose that the instruction includes a parameter that identifies a different application to perform a next instruction after executing said synchronization instruction. However, such a feature was well known in the art at the time of Applicant's invention. Specifically, like Hawkins, Grambihler discloses using synchronization instructions that contain parameters [column 34 «lines 18-59»]. Unlike Hawkins however, Grambihler expressly discloses an instruction that includes at least one control parameter identifying a different application to perform a next instruction after executing said synchronization instruction [column 27 «line 43» to column 28 «line 6»]. Grambihler teaches a method containing parameters that allow a calling application to specify a different application. This feature reads on Applicant's claimed limitation.

It would have been obvious to one of ordinary skill in the art to have modified Alam and Hawkins' synchronization instruction to include parameters that specify a different application for execution as taught by Grambihler. Implementing parameters within a command or instruction was well known in the art at the time of Applicant's invention. One of ordinary skill in the art would have been to modify Alam and Hawkins instruction to offer a user greater control over the applications that are run in his system. Moreover, such a modification is an example of applying a known technique [Grambihler's method containing parameters specifying a different application] to a known device (method, or product) [Alam's synchronization system] ready for improvement to yield predictable results [after synchronization, calling a second application].

9. Some claims will be discussed together. Those claims which are essentially the same except that they set forth the claimed invention as an apparatus are rejected under the same rationale applied to the described claim.

10. Thereby, the combination of Alam, Hawkins, and Grambihler discloses:

- <Claim 1>

A method of reconciling data between a host device wirelessly connected to a personal data assistant, comprising:

commencing execution of an application on said personal data assistant (Alam, column 10, lines 44-52);

executing a synchronization instruction from said application (Alam, Figure 1 | column 10, lines 53-62 and column 12, lines 15-63 where the manager application runs on the personal data assistant and executes methods to perform synchronization), said synchronization instruction comprising at least one parameter including a control parameter identifying a different application to perform a next instruction after executing said synchronization instruction [see Hawkins, column 8 «lines 11-15» and Grambihler, column 27 «line 43» to column 28 «line 6»];

launching a first synchronization process on said personal data assistant in response to said executing a synchronization instruction from said application on said personal data assistant [Alam, column 12 «line 56» to column 13 «line 5»: Sync manager on the PDA calls methods and interfaces to being the synchronization in response the sync event and instruction | column 13 «lines 38-49»];

launching a second synchronization process on said host device in response to said executing said synchronization instruction from said application on said personal data assistant [column 13 «lines 2-5 and 38-49»]; and

synchronizing data over a wireless connection stored in said personal data assistant with data stored in said host device (Alam, column 13, lines 6-17 and column 5, lines 36-52), by said synchronizing is performed by said first synchronization process and said second synchronization process (Alam, column 13, lines 38-49: Alam's methods and interfaces called by the sync managers on the host device and PDA read on Applicant's claimed synchronization process).



- <Claim 2>

The method of claim 1, further comprising: establishing a TCP/IP communication link between said host device and said personal data assistant for synchronizing said data (Alam, column 5, lines 35-52).

- <Claim 6>

The method of claim 5, wherein: said at least one parameter identifies data for synchronization (Alam, column 11, lines 44-61).

- <Claim 7>

The method of claim 6, wherein: said identified data includes data stored in at least one database in said personal data assistant that is synchronized with data stored in an associated database in said host device (Alam, column 10, lines 53-62).

- <Claim 9>

The method of claim 5, wherein said step of executing a synchronization instruction further comprises: extracting said at least one parameter from said synchronization instruction; and storing said at least one parameter in memory in said personal data assistant (Alam, column 12, lines 48-67).

- <Claim 10>

The method of claim 9, wherein said executing a synchronization instruction further comprises: retrieving said stored at least one parameter from said memory; and executing from said application said synchronization instruction with said retrieved at least one parameter (Alam, column 12, line 67 through column 13, line 17).

- <Claim 11>

The method of claim 1, wherein: said executing a synchronization instruction from said application further comprises executing said synchronization instruction in response to an event (Alam, column 10, lines 44-52).

- <Claim 12>

The method of claim 11, wherein: said event comprises selecting a button or icon displayed by said application on said personal data assistant (Alam, column 9, lines 14-22).

- <Claim 13>

The method of claim 11, wherein: said event comprises selecting a menu item displayed by said application on said personal data assistant (Alam, column 9, lines 14-22).

- <Claim 14>

The method of claim 11, wherein: said event comprises one of selecting a form and closing a form displayed on said personal data assistant (Alam, column 8, lines 9-14).

- <Claim 15>

A system comprising:

a personal data assistant comprising at least one first database (Alam, figure 1, items 12, 20, and 22) and adapted to execute an application and a synchronization instruction, and launch a first synchronization process on said personal data assistant in response to said synchronization instruction [Alam, column 12 «line 56» to column 13 «line 5»: Sync manager on the PDA calls methods and interfaces to being the

synchronization in response the sync event and instruction | column 13 «lines 38-49»];

and

a host device adapted to be connected to said personal data assistant over a wireless connection and including at least one second database (Alam, figure 1, items 14, 32, and 34 and column 5, lines 36-52), and adapted to launch a second synchronization process on said host device in response to said synchronization instruction [column 13 «lines 2-5 and 38-49], with synchronization between said personal data assistant and said host device being performed by said first synchronization process and said second synchronization process [Alam, column 13, lines 38-49: Alam's methods and interfaces called by the sync managers on the host device and PDA read on Applicant's claimed synchronization process];

wherein said synchronization instruction comprises at least one parameter including a control parameter identifying a different application to perform a next instruction after executing said synchronization instruction [see Hawkins, column 8 «lines 11-15» and Grambihler, column 27 «line 43» to column 28 «line 6»].

- <Claim 16>

The system of claim 15, wherein said personal data assistant further comprises: a runtime engine executing said application (Alam, figure 1, item 24); and a memory storing a program file received from said host device, said program file including said synchronization instruction executed by said personal data assistant (Alam, column 4, line 43 through column 5, line 11 and column 8, lines 34-49).

- <Claim 17>

The system of claim 16, wherein: said runtime engine is configured to retrieve said synchronization instruction from said program file and execute said synchronization instruction (Alam, column 12, line 48 through column 13, line 17).

- <Claim 18>

The system of claim 17, wherein: a first synchronization process is launched on said personal data assistant and a second synchronization process is launched on said host device for synchronizing in response to said execution of said synchronization instruction (Alam, figure 6, items 140 and 148).

- <Claim 19>

The system of claim 17, wherein: said host device further comprises an integrated design environment configured to generate said application and said program file, said application and said program file being downloaded to said personal data assistant from said host device through a communication link (Alam, column 5, lines 28-52).

- <Claim 20>

A data synchronization system comprising:

a host computer including an integrated design environment (Alam, figure 1, item 14), a first plurality of databases (Alam, figure 1, items 32 and 34), and at least one application (Alam, figure 1, item 30), wherein said host computer is configured to generate said at least one application and a program file including instructions executed with said application (Alam, column 5, lines 28-34);

a personal data assistant connected to said host computer through a wireless connection (Alam, figure 1, item 12 and column 5, lines 36-52), said personal data assistant comprising a runtime engine (Alam, figure 1, item 24) to execute said application and a second plurality of databases (Alam, figure 1, items 20 and 22), and adapted to launch a first synchronization process on said personal data assistant in response to said synchronization instruction [Alam, column 12 «line 56» to column 13 «line 5»: Sync manager on the PDA calls methods and interfaces to being the synchronization in response the sync event and instruction | column 13 «lines 38-49»]; and

a host device adapted to launch a second synchronization process in response to said synchronization instruction, synchronization between said personal data assistant and said host device being performed by said first synchronization process and said second synchronization process [Alam, column 13, lines 38-49: Alam's methods and interfaces called by the sync managers on the host device and PDA read on Applicant's claimed synchronization process];

wherein said personal data assistant is configured to receive said at least one application and program file from said host computer (Alam, column 5, lines 28-52), and said runtime engine is configured to initiate said at least one application and synchronization instruction in said program file, said synchronization instruction comprises at least one parameter including a control parameter identifying a different application to perform a next instruction after executing said synchronization instruction

[see Hawkins, column 8 «lines 11-15» and Grambihler, column 27 «line 43» to column 28 «line 6»].

- <Claims 21, 26, and 27>

A method of synchronizing data between a personal data assistant and a remote computer, comprising:

selecting from said personal data assistant which files on said personal data assistant to synchronize with said remote computer (Alam, column 12, line 48 through column 13, line 5);

establishing wireless communications between said personal data assistant and said remote computer (Alam, column 10, lines 53-62; column 12, lines 15-26; and column 5, lines 36-52); and

running an application on said personal data assistant (Alam, Figure 1 «items 24, 16, 18» | Figure 6 «items 140, 144, 146»), said application comprising a synchronization instruction comprising at least one parameter including a control parameter identifying a different application to perform a next instruction after executing said synchronization instruction [see Hawkins, column 8 «lines 11-15» and Grambihler, column 27 «line 43» to column 28 «line 6»];

launching a first synchronization process on said personal data assistant in response to said synchronization instruction [Alam, column 12 «line 56» to column 13 «line 5»: Sync manager on the PDA calls methods and interfaces to being the synchronization in response the sync event and instruction | column 13 «lines 38-49»];  
and

launching a second synchronization process on said host device in response to said synchronization instruction [column 13 «lines 2-5 and 38-49»];

wherein said synchronization between said personal data assistant and said host device being performed by said first synchronization process and said second synchronization process [Alam, column 13, lines 38-49: Alam's methods and interfaces called by the sync managers on the host device and PDA read on Applicant's claimed synchronization process].

- <Claims 22 and 28>

The method of synchronizing data between a personal data assistant and a remote computer according to claim 21, wherein: said synchronizing is performed over a wireless connection (Alam, column 5, lines 36-52).

- <Claims 23 and 29>

The method of synchronizing data between a personal data assistant and a remote computer according to claim 21, wherein: said synchronizing synchronizes a first database on said personal data assistant with a second database on said remote computer (Alam, column 10, lines 53-62).

- <Claims 24 and 30>

The method of synchronizing data between a personal data assistant and a remote computer according to claim 21, further comprising: selecting a button or icon displayed by an application on said personal data assistant (Alam, column 9, lines 14-22).

- <Claims 25 and 31>

The method of synchronizing data between a personal data assistant and a remote computer according to claim 21, further comprising: selecting a menu item displayed by an application on said personal data assistant (Alam, column 9, lines 14-22).

Since the combination of Alam and Hawkins discloses all of the above limitations, claims 1, 2, 6, 7, and 9-31 are rejected.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571.272.3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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